PATENT

AF/2773 #17 9/14/01

- 1 -

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:	:	Examiner:
R. Bertram et al.		B. Huynh
Serial No.: 09/143,967	:	Group Art Unit: 2173
Filed: August 31, 1998	:	Intellectual Property Law
	:	IBM Corporation
Title: MOBILE CLIENT	:	Dept. 972/B656
COMPUTER TO PREDICT	:	P.O. Box 121
INPUT	:	Research Triangle Park, NC 27709

September 4, 2001

TRANSMITTAL LETTER

Box AF
Assistant Commissioner for Patents
Washington, D. C. 20231

Dear Sir:

Transmitted herewith are three (3) copies of the Reply Brief and an Acknowledgment Postcard.

CERTIFICATION UNDER 37 C.F.R. § 1.8

I hereby certify that this correspondence (along with any item referred to as being enclosed herewith) is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Box AF, Assistant Commissioner for Patents, Washington, D.C. 20231, on September 4, 2001.

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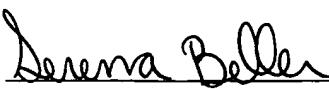
Serena Beller_____
(Printed name of person certifying)

☒   No fee is due, however, the Assistant Commissioner is hereby authorized to charge any insufficiency in fees associated with this communication, or credit any overpayment, to Deposit Account No. 09-0464 (RP9-95-017V). **A duplicate copy of this transmittal letter is attached.**

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorney for Applicants

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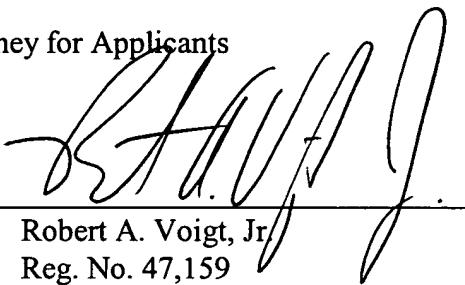
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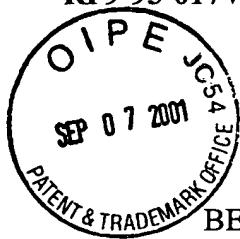
RP9-95-017V   **PATENT**

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September 4, 2001

REPLY BRIEF

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

    This Reply Brief is being submitted in response to the Examiner's Answer dated July 18,

2001 (Paper No. 16), with a two-month statutory period for response set to expire on September 18,

2001.

CERTIFICATION UNDER 37 C.F.R. § 1.8

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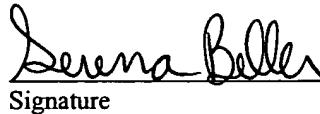
Serena Beller
Signature

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(Printed name of person certifying)

I.   AMENDMENTS AFTER FINAL

In the Notice of Non-Compliance having a mailing date of June 29, 2001, the Examiner stated that claims 46, 58 and 70 were objected to but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Appellants amended claims 46, 58 and 70 to include the limitations of the base and intervening claims in an amendment in accordance with 37 C.F.R. §1.116 filed concurrently with the Supplemental Brief filed on July 3, 2001. In the Examiner's Answer having a mailing date of July 18, 2001, the Examiner states that "the amendment after final rejection filed on 7/06/01 has not been entered because the appellants had failed to rewrite all limitation of claim 58 into its base claim." See Examiner's Answer, Page 2. Appellants' contest the Examiner's assertion that claim 58 was not rewritten to include all the limitations of the base and intervening claims. Appellants respectfully request the Examiner to re-examine claim 58.

II.   RESPONSE TO EXAMINER'S ARGUMENTS

A.   The Examiner states that "Dipaolo et al teach a system/method for automatically fill-in a data filed with an item determined as the only data entry (*therefore is the most probable data entry*), thus save the user from selecting the item for the data field. It would have been obvious to one of ordinary skill in the art, at the time the invention was made, to combine Dipaolo's teaching of auto-fill to Capps' data entry for *automatically fill-in a data field with a top-most item in Capps' historical list, which is the most probably entry to be selected by the user*. Motivation for the combining is for the ease of data entry by saving the user from manually selecting the entry." See Examiner's Answer, Page 5. Appellants respectfully contest the assertion that filling an entry in a data field that can only have one entry is associated with any probability. Appellants assert that there is no probability when there is only one answer. For example, the answer to the question of what is the result of 2 plus 2 is 4. Is there a probability associated with the answer? No. There is only

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one answer. The number 4. Similarly, as interpreted by the Appellants, the Dipaolo et al. (U.S. Patent No. 5,367,619) (hereinafter "Dipaolo") reference teaches filling in the field that has only one answer, i.e., only one valid data entry. As interpreted by the Appellants, Dipaolo teaches filling in a field when there is no probability of what the user may select. Dipaolo does not teach filling a field when there is a probability of what the user may select. For example, if there is a 20% probability that the user will select the number 2 and if there is an 80% probability that the user will select the number 4, Dipaolo does not teach filling in the number 4 in the field as there is a probability associated with it. There are two possibilities, i.e., the numbers 2 and 4, as to which number a user may select.

Capps (U.S. Patent No. 5,666,502) teaches that "the *historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data. Preferably, the *historical list is displayed over a form* also being displayed that requires the data input into its one or more of its fields. *By using the historical lists a user is able to enter data with a greater ease of use than previously obtainable.*" See Abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the *user can click, tap or otherwise select the history list indicator 186 to obtain the history list for names.* Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith." See Column 10, Lines 60-66. As interpreted by the Appellants, the purpose of having a *historical list in Capps is to provide a list of a plurality of valid data entries* the user may select. There is not just one valid entry. Therefore, there is *no motivation to combine Capps with Dipaolo as there would be no automatic filling because the fields have more than one valid entry.* That is, there is no motivation to combine Capps with Dipaolo as there would be no automatic filling because Dipaolo does not teach automatically filling an item that has a probability associated with it.

B.   The Examiner states that "it has been held that the *test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference;* nor is it that the claimed invention must be expressly suggested in any one or all of the

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references." See Examiner's Response, Page 6. Appellants respectfully point out that the Examiner has misconstrued Appellants' arguments presented in Appellants' Appeal Brief having a filing date of May 1, 2001. Appellant has not argued that the features of Dipaolo *may not bodily* be incorporated *into the structure* of Capps. Appellants respectfully reiterate their argument that the Examiner must *consider the references in their entirety, i.e., as a <u>whole</u>, including portions that would lead away from the claimed invention. See W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. §2141.02. Dipaolo teaches that "fields which have only *one valid data entry* which is dependent upon entries made for designated other fields may be *designated automatically.*" See Column 2, Lines 50-53. As interpreted by the Appellants, the Examiner simply focuses on the feature of automatically entering the data of a specific data field *without the limitation that Dipaolo specifically limits the filling feature to those fields with only one defined data entry*. That is, *Dipaolo specifically limits the filling feature to those fields in which there is no probability as to what the user would select*. The Examiner *must not separate the limitation specifically stated in Dipaolo as the Examiner must consider the entire reference*.

C.   The Examiner states that "the appellants further argue that Capps as combined with Dipaolo would change the principle operation in Capps. This argument has no support from either Capps or Dipaolo." See Examiner's Response, Page 6. As stated above, as interpreted by the Appellants, Dipaolo teaches filling in a field when there is no probability of what the user may select. Dipaolo does not teach filling a field when there is a probability of what the user may select. Subsequently, combining Dipaolo that teaches filling in a field when there is no probability of what the user may select with Capps that teaches providing a *historical list to provide a list of a plurality of valid data entries* the user may select would change the principle of operation of Capps. Capps would no longer be able to provide a list of a plurality of valid data entries as the filling feature of Dipaolo is limited to only when there is one valid data entry for that field. If the proposed modification or combination of the prior art would *change the principle of operation of the prior art*

invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *See In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Furthermore, if the proposed modification would *render the prior art invention being modified unsatisfactory for its intended purpose*, then there is no suggestion or motivation to make the proposed modification. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

D.   Appellants believe that their argument as to why the combination of Capps and Dipaolo do not teach or suggest "exercising a predictive widget to supply a data entry for a defined data field" has been sufficiently explained in the Appeal Brief filed on May 1, 2001.

E.   The Examiner states that "the list of most probably choices disclosed by Capps as combined with Dipaolo auto-fill met the language 'one of a predictive default and a predictive fill' as recited in the claim." See Examiner's Response, Page 8. Furthermore, the Examiner states "it has been held that one cannot shown nonobviousness by attacking references individually where the rejections are based on combination of references." See Examiner's Response, Pages 7-8. Appellants assert that Appellants have not attacked references individually but on the contrary asserted that Capps and Dipaolo, taken singly or in *combination*, do not teach or suggest that " *exercising a predictive widget to supply one of a predictive default and a predictive fill...for the defined data field*" as recited in claims 48, 60 and 72. As stated above, as interpreted by the Appellants, Dipaolo teaches filling in a field *when there is no probability of what the user may select*. Dipaolo does not teach filling a field when there is a probability of what the user may select. That is, *Dipaolo does not teach a predictive widget to supply one of a predictive default and a predictive fill*. Furthermore, the Examiner states that Capps does not teach "to supply a data entry for a defined field." See Examiner's Response, Page 4; See Office Action (dated August 2, 2000), Page 3. Therefore, Capps and Dipaolo, taken singly or in combination, do not teach or suggest "*exercising a predictive widget to supply one of a predictive default and a predictive fill...*for the defined data field" as recited in claims 48, 60 and 72.

F.   The Examiner states that "as for the limitation 'storing a predictive list and *selecting a predictive default entry from the predictive list* based on a predetermined algorithm', appellants argue that since Dipaolo teaches only one entry value therefore does not teach the selecting a predictive default entry from the predictive list as claimed. Again, one cannot show nonobviousness by attacking references individually where the rejections are based on combination of references." See Examiner's Response, Page 8. Appellants assert that Appellants have not attacked references individually but on the contrary asserted that Capps and Dipaolo, taken singly or in *combination*, do not teach or suggest that "in storing a predictive list and *selecting a predictive default entry from the predictive list* based on a predetermined algorithm" as recited in claims 39, 51 and 63 and similarly in claims 40, 41, 42, 52, 53, 54, 64, 65 and 66. Capps teaches that "the *historical list contains the most recently and/or frequently used data values* for the data field that the user is inputting data." See abstract. Capps further teaches that "in any case, when the user seeks to enter data into the name field 184, the user can click, tap or otherwise *select the history list indicator 186 to obtain the history list for names*. Preferably, each history list is associated with a field class. The input fields of a form then designate the field class associated therewith. See Column 10, Lines 60-66. As interpreted by the Appellants, Capps simply teaches providing a history list but that the user must select an entry from the history list. Furthermore, as stated above, as interpreted by the Appellants, Dipaolo teaches filling in a field *when there is no probability of what the user may select. Dipaolo does not teach selecting an entry from a predictive list*. Therefore, Capps and Dipaolo, taken singly or in *combination*, do not teach or suggest that " in storing a predictive list and *selecting a predictive default entry from the predictive list* based on a predetermined algorithm" as recited in claims 39, 51 and 63 and similarly in claims 40, 41, 42, 52, 53, 54, 64, 65 and 66.

G.   The Examiner states "in response to the argument that the combined references do not teach a predictive list based upon the recency (claims 43, 55, 67) or frequency alone (claims 44, 56, 68), the language of the claims do not exclude recency from frequency or vice versa." See Examiner's Response, Page 8. Appellants respectfully point out that the Examiner has misconstrued

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Appellant's arguments presented in Appellant's Appeal Brief having a filing date of May 1, 2001. The argument presented in Appellant's Appeal Brief having a filing date of May 1, 2001 was that "Capps and Dipaolo, taken singly or in combination, do not teach or suggest that 'when the computer program is executing on the processor, in *selecting a data entry* from the predictive *list based upon the recency of use of listed data entries*'" as recited in claims 43, 55 and 67. See Appeal Brief, Page 11. Furthermore, the Appellants argued that Capps and Dipaolo, taken singly and in combination, do not teach or suggest that "when the computer program is executing on the processor, in *selecting a data entry* from the predictive list *based upon the frequency of use of listed data entries*" as recited in claims 44, 56 and 68." See Appeal Brief, Page 11. Since the Examiner has failed to address the element of "*selecting a data entry* from the predictive list" that is "*based upon the frequency/recency of use of listed data entries*", Appellants presume that the Examiner has not been able to identify art that refutes Appellants' argument presented in the Appeal Brief.

H.   The Examiner states that "in response to the argument that the combined references do not teach a predictive list based upon a user selected weighted determination of the recency and frequency of use of listed date entry, Capps discloses a predictive list that has data values ordered based upon a user selected weight determination of the recency and frequency of used." See Examiner's Response, Page 9. Appellants respectfully point out that the Examiner has misconstrued Appellant's arguments presented in Appellant's Appeal Brief having a filing date of May 1, 2001. The argument presented in Appellant's Appeal Brief having a filing date of May 1, 2001 was that "Capps and Dipaolo, taken singly and in combination, do not teach or suggest that 'when the computer program is executing on the processor, in *selecting a data entry* from the predictive list *based upon a user selected weighted determination of the recency and frequency of use of listed data entries*'" as recited in claims 45, 57 and 69. See Appeal Brief, Page 11. Since the Examiner has failed to address the element of "*selecting a data entry* from the predictive list" that is "*based upon a user selected weighted determination of the recency and frequency of use of listed data*",

Appellants presume that the Examiner has not been able to identify art that refutes Appellants' argument presented in the Appeal Brief.

III.   <u>CONCLUSION</u>

Applicants respectfully assert that the claims are patentable over the cited prior art.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

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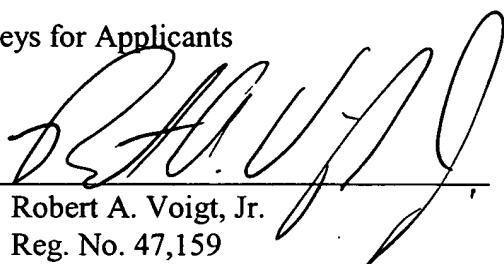
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